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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,438	11/20/2001	Wataru Takagi	16869S-038200US	8547

20350	7590	09/23/2005		

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EXAMINER
FRANCIS, MARK P

ART UNIT	PAPER NUMBER
2193	

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/988,438	TAKAGI ET AL.
	Examiner	Art Unit	
	Mark P. Francis	2193	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _20 November 2001_.

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-5_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-5_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _20 November 2001_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All b) ☐ Some * c) ☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _11/20/01; 1/3/05._

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the application filed on November 20, 2001.

2.   Claims 1-5 have been examined.

Foreign Priority Date

3.   The foreign priority date considered for this application is January 18, 2001.

Oath/Declaration

4.   The Office acknowledges receipt of a properly signed oath/declaration filed April

15, 2002.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6.   Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

Statutory subject matter requires two things:

> (1)   it must be in the "useful arts," U.S. Const., art. I, 8, cl.8,

In this instance, the language of the claims raises a question as to whether the

claims are directed merely to an abstract idea that is not tied to a technological art,

environment or machine which would result in a practical application producing a useful,

concrete, and tangible result to form the basis of statutory subject matter under 35

U.S.C. 101; and if it is,

(2)   it must not fall within one of the exceptions for "laws of nature,

physical phenomena and abstract ideas."

Under the most recent Federal Circuit cases, transformation of data by a

machine (e.g., computer) is statutory subject matter provided the claims recite a

"practical application, which produce[s] a useful, concrete and tangible result."

State St. Bank & Trust Co. v. Signature Fin. Group, Inc. 149 F.3d 1368, 1373, 47

USPQ2d 1596, 1600-01 (Fed. Cir. 1998).

Regarding claims 1-4,

Recite a data transcribing program for representing data from data structures of a mark-

up language to a data structure of a program language and vice verse. This data

transcribing program is merely a software entity, i.e., computer program per se. Such

claimed matter, which is non-functional descriptive material per se, is not statutory

because while the claim may be (it is noted that structure will not be read into the claim

for the purposes of the statutory subject matter analysis) in the technological arts, i.e.,

machine, it falls within the exception for abstract ideas.

Regarding claim 5,

In this instance, the language of the claim raises a question as to whether the

claim is directed merely to an abstract idea that is not tied to a technological art,

environment or machine which would result in a practical application producing a useful,

concrete and tangible result to form the basis of statutory subject matter under 35 USC

101.

Furthermore, the Office's interpretation of this claim is that it does not expressly

or implicitly require performance of any of the steps by a machine such as general-

purpose digital computer. Structure will not be read into the claims for the purpose of

the statutory subject matter analysis even though the steps might be capable of being

performed by a machine.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the

rejections under this section made in this Office action:

8.   A person shall be entitled to a patent unless --

> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

9.   Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Corbin

(US Pat 6,594,823)

Independent claims

With respect to claims 1 and 5, Corbin discloses a data transcribing program for

transcribing data from data structure of a structured document to data structure of a

program language(Col 4:1-38, "…each mark-up language…the data structure being

represented…rendered into any of a number of high-level language source codes…"),

including codes for executing the steps of:

acquiring definition information on document structure of said structured document,

definition information on a structure of said program language(e.g. See Fig. 2 and

related text), and correspondence information between said document structure of said

structured document and said structure of said program language, creating, based on

said acquired information, (Col 5:1-45, "…above-described rules…",e.g. See Figs. 2 and

3, and related text)

a flag structure for storing state of said structure of said program language, and a

structure of said program language corresponding to said flag structure, (Col 5:35-67,

"…monitoring the status…represents a data structure for holding status information…",

Col 6:22-34, "…to the state of each machine…")

and using said created flag structure and said created structure of said program

language corresponding to said flag structure, thereby transcribing said data from said

data structure of said structured document to said data structure of said program

language. (Col 6:43-67, "…a translation program…")

With respect to claim 2, Corbin discloses A data transcribing program for transcribing

data from data structure of a program language to data structure of a structured

document,(Col 3:57-67, "...a method and system of representing a high-level

programming language data structure in a mark-up language...") including codes for

executing the steps of:

 acquiring definition information on document structure of said structured document,

(e.g. See Fig. 2 and related text) definition information on a structure of said program

language, and correspondence information between said document structure of said

structured document and said structure of said program language, creating, based on

said acquired information, Col 5:1-45, "...above-described rules...",e.g. See Figs. 2 and

3, and related text)

a flag structure for storing state of said structure of said program language, and a

structure of said program language corresponding to said flag structure, (Col 5:35-67,

"...monitoring the status...represents a data structure for holding status information...",

Col 6:22-34, "...to the state of each machine...")

and using said created flag structure and said created structure of said program

language corresponding to said flag structure, thereby transcribing said data from said

data structure of said program language to said data structure of said structured

document. (Col 6:43-67, "...a translation program...")

With respect to claim 4, Corbin discloses A program for converting data structure in an inter-enterprise system, wherein data structure of a structured document used in common among said enterprises is determined in advance(Col 3:1-35, "...enterprise-wide computer networks..."), including codes for executing the steps of:

acquiring definition information on said data structure of said structured document used among said enterprises, definition information on a structure of a program language used inside each enterprise(Col 3:5-67, "...enterprise-wide computer networks..."), and correspondence information between said data structure of said structured document used among said enterprises and said structure of said program language used inside said each enterprise, creating, based on said acquired information, (Col 5:1-45, "...above-described rules...",e.g. See Figs. 2 and 3, and related text)

a flag structure for storing state of said structure of said program language, and a structure of said program language corresponding to said flag structure, (Col 5:35-67, "...monitoring the status...represents a data structure for holding status information...", Col 6:22-34, "...to the state of each machine...")

and using said created flag structure and said created structure of said program language corresponding to said flag structure. (Col 6:43-67, "...a translation

program...")

Dependent claim

With respect to claim 3, the rejection of claim 1 is incorporated and further, Corbin

discloses that said flag structure includes presence or absence of said data, number of

occurrences of said data, type of said data, and length of said data, said data being

included in said structure of said program language. (Col 4:21-51, "...contains the

variable name and the variable type...", Col 6:6-34, "...The types defined...", e.g. See

Fig. 2 and related text)

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

11.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Mark P. Francis whose telephone number is (571) 272-

7956. The examiner can normally be reached on Mon-Fri 8:00-4:30.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Mark P. Francis

Patent Examiner

Art Unit 2193

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